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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,270	10/20/2003	Ve-Chung Hui	USP2131H-ONC	3780
30265	7590	08/08/2005	EXAMINER	
RAYMOND Y. CHAN			TRUONG, BAO Q	
108 N. YNEZ AVE., SUITE 128			ART UNIT	
MONTEREY PARK, CA 91754			PAPER NUMBER	
			2875	

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,270	<b>Applicant(s)</b> HUI, VE-CHUNG	
	<b>Examiner</b> Bao Q. Truong	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9,11 and 13 is/are rejected.
- 7) ☒ Claim(s) 3,4,7,8,10,12 and 14-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1 and 5-8 are objected to because of the following informalities:  
  
Claim 1, "comprising" in lines 8 and 13 should be changed to --including--.  
  
Claims 5-8, there is lack of antecedent basis for "said holder body" in line 2.  
  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Shu [US 6,129,473].

Regarding claim 1, Shu discloses an illuminating pen having a hollow writing unit holder [1] with a cavity, a battery [3] and a writing unit [6], a light dispersing cone [4], an illuminator [51], and a control switch [bottom end of the writing unit 6 and springs 35, 55] (abstract, figures 1-7).

Regarding claim 5, Shu discloses a light dispersing cone [4] having a cone edge securely affixed to an inner surface of a writing unit holder [1] (figure 7).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu [US 6,129,473] in view of Hui [US 6,837,639].

Regarding claim 2, Shu discloses a light dispersing means [teeth-like] (column 2 lines 35-40), but does not disclose a plurality of light guiding channels.

Hui teaches the use of a plurality of light guiding channels [15'] for an illuminable writing instrument (figure 4, column 6 lines 1-8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the light dispersing means of Shu with the plurality of light guiding channels as taught by Hui for purpose of providing an advantageous way of diffusing light toward an end.

Regarding claim 6, Shu discloses a light dispersing cone [4] having a cone edge securely affixed to an inner surface of a writing unit holder [1] (figure 7).

Regarding claim 13, Hui teaches a retaining member [50] attached to an end of a writing unit [20] and against an inner surface of a writing unit holder [10] (figures 1-4).

6. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu [US 6,129,473] in view of S.J. Hoenig [US 3,045,111].

Regarding claims 9 and 11, Shu discloses an illuminator [51] but does not disclose the magnifying lens having the transparent convex-concave surface aligned with the illuminator.

S.J. Hoenig teaches the use of a magnifying lens [25] having a transparent convex-concave surface aligned with an illuminator [27] (figures 1-4).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the magnifying lens having the transparent convex-concave surface aligned with the illuminator as taught by S.J Hoenig for purpose of providing an advantageous way of directing light toward an end.

#### ***Allowable Subject Matter***

7. Claims 3, 4, 7, 8, 10, 12 and 14-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 3, the illuminable writing instrument further comprises a transparent tubular light enhancing shelter to receive a writing unit holder and cover the light guiding channels.

Claims 4, 7, 8, 10, 12 and 14-20 are dependent on claim 3.

The limitations discussed above are neither disclosed nor suggested by the prior art of record.

**Conclusion**

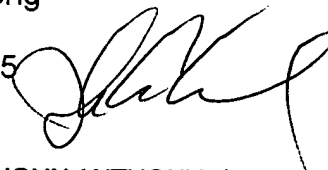
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cheng [US 6,431,720] and Gao [US 6,682,212] disclose an illuminable pen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Q. Truong whose telephone number is (571) 272-2383. The examiner can normally be reached on Monday-Friday (8:00 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Q. Truong  
Examiner  
Art Unit 2875



**JOHN ANTHONY WARD**  
**PRIMARY EXAMINER**